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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/061,835	01/31/2002	Frank J. Landherr	112713-115	9493

29200 7590 10/17/2003

BAXTER HEALTHCARE CORPORATION
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EXAMINER

KILKENNY, TODD J

ART UNIT	PAPER NUMBER
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1733

DATE MAILED: 10/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/061,835

Applicant(s)

LANDHERR ET AL.

Examiner

Todd J. Kilkenney

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-88 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-88 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____. | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1 – 14 and 47 - 50, drawn to a method of connecting two tube ends of flexible, classified in class 156, subclass 304.6.
 - II. Claims 15 – 46 and 87, drawn to a device for connecting two thermoplastic tube ends together, classified in class 156, subclass 500.
 - III. Claims 51 - 59, drawn to a method of disconnecting a flexible tube, classified in class 156, subclass 251.
 - IV. Claims 60 - 82, drawn to a device for providing a disconnection of a flexible tube, classified in class 156, subclass 515.
 - V. Claims 83 and 88, drawn to a device to connect two flexible tube ends and disconnect a single flexible tube, classified in class 156, subclasses 500 and 515.
 - VI. Claim 84, drawn to a method of connecting two flexible tube ends and disconnecting a flexible tube, classified in class 156, subclasses 251 and 304.6.
 - VII. Claim 85, drawn to a method of providing dialysis treatment, classified in class 604, subclass 29.
 - VIII. Claim 86, drawn to a method of disconnecting a patient from dialysis treatment, classified in class 604, subclass 29.

Applicant is first asked to elect between the method groups (I, III, VI, VII, VIII) and device groups (II, IV, V) as rendered distinct for the following reasons:

2. Inventions I and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus as claimed can be used to practice another and materially different process such as splicing together fiber bundles as opposed to two flexible tube ends.

3. Inventions III and IV are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus as claimed can be used to practice another and materially different process such as laser cutting a single length fiber bundle into two separate lengths.

4. Inventions VI and V are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP §

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806.05(e)). In this case the apparatus as claimed can be used to practice another and materially different process such as splicing together fiber bundles to form a single length and thereafter laser cut the single length bundle into two separate lengths with crimped ends.

5. Inventions VII and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the process of group VII can be practiced by another materially different apparatus such as an apparatus that doesn't require the pair of tube holders as required by group II.

6. Inventions VIII and IV are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the process of group VIII can be practiced by another materially different apparatus such as an apparatus that doesn't require the pair of guides as required by group IV.

If the method groups are elected, applicant is further asked to elect between the method of connecting or the method of disconnecting or the combination method of connecting and disconnecting as restricted as explained below:

7. Inventions I and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as being employed solely to connect two tube ends to form a single length flexible tubing that is not later disconnected. See MPEP § 806.05(d).

8. Inventions VI and I are related as combination and subcombination. Here the combination claim recites particular characteristics of the subcombination that are not essential to the combination. Characteristics of A(specific) can be used as a basis for showing that B(specific) does not constitute the sole distinguishing novelty in the combination. That is, the characteristics of the connection method can be used as a basis for showing that the disconnection method does not constitute the sole distinguishing novelty. It is noted upon allowance of group I, if having been elected, rejoinder of group VI will be considered.

9. Inventions VI and III are related as combination and subcombination. Here the combination claim recites particular characteristics of the subcombination that are not essential to the combination. Characteristics of B(specific) can be used as a basis for showing that A(specific) does not constitute the sole distinguishing novelty in the

combination. That is, the characteristics of the disconnection method can be used as a basis for showing that the connection method does not constitute the sole distinguishing novelty. It is noted upon allowance of group III, if having been elected, rejoinder of group VI will be considered.

10. Inventions VII and I are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the combination doesn't comparing the weld characteristics to a weld profile. The subcombination has separate utility such as connecting fiber bundle tubing as opposed to medical tubing.

11. Inventions VIII and III are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the combination does not require striking a laser beam at the compressed area and sealing the compressed area and separating in to two tubes, each tube having a sealed end.

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The subcombination has separate utility such as disconnecting fiber bundle tubing as opposed to medical tubing.

12. If applicant elects the device groups, applicant is further asked to elect between the device for connecting, the device for disconnecting or the combination device for connecting and disconnecting as explained below:

13. Inventions II and IV are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention II has separate utility such as being employed to solely connect two tube ends to form single length flexible tubing that is not later disconnected. See MPEP § 806.05(d).

14. Inventions V and II are related as combination and subcombination. Here the combination claim recites particular characteristics of the subcombination that are not essential to the combination. Characteristics of A(specific) can be used as a basis for showing that B(specific) does not constitute the sole distinguishing novelty in the combination. That is, the characteristics of the connection device can be used as a basis for showing that the disconnection device does not constitute the sole distinguishing novelty. It is noted upon allowance of group II, if having been elected, rejoinder of group V will be considered.

15. Inventions V and IV are related as combination and subcombination. Here the combination claim recites particular characteristics of the subcombination that are not essential to the combination. Characteristics of B(specific) can be used as a basis for showing that A(specific) does not constitute the sole distinguishing novelty in the combination. That is, the characteristics of the disconnection device can be used as a basis for showing that the connection device does not constitute the sole distinguishing novelty. It is noted upon allowance of group IV, if having been elected, rejoinder of group V will be considered.

16. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

17. A telephone call was made to Robert Barrett on October 14, 2003 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

18. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one

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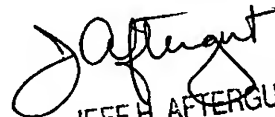
or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Todd J. Kilkenny** whose telephone number is **(703) 305-6386**, or if attempting to contact after December 22, 2003 (571) 272-1219. The examiner can normally be reached on Mon - Fri (9 - 5).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

TJK

TJK


JEFF H. AFTERGUT
PRIMARY EXAMINER
GROUP 1300